

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 5-15, 17-20, 22-25, 27, 31, 34-50, 91, 96-211, 216-222, 224-235 and 245-260 have been withdrawn from consideration as being drawn to a nonelected invention; Claims 1-4, 32 and 33 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement; Claims 212 and 223 have been rejected under 35 U.S.C. §112, second paragraph, as being vague and indefinite; and Claims 1-4, 32, 33, 212-215 and 223 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Danks (USP 5,868,773, hereinafter Danks '773) in view of Danks (USP 5,607,440, hereinafter Danks '440). Claims 5-15, 34-11, 216-222 and 224-260 have been canceled, without prejudice, and thus, Claims 1-4, 32, 33, 212-215 and 223 remain active.

Considering next then the rejection of Claims 1-4, 32 and 33 under 35 U.S.C. §112, first paragraph, Applicant notes that the entire contents and disclosure of U.S. Parent Application 09/598,453 was referred to in the background of the invention in the present application as filed wherein the entire contents and disclosure of such application were incorporated by reference. In view of this and in view of the Examiner's indication that Claim 42 of such parent application referred to the guard as having a substantially planar portion thereof extending substantially parallel to the cutting blade, it is submitted that the recitation of a "substantially planar guard" in Claims 1-4, 32 and 33 has proper antecedent basis and does not fail to comply with the written description requirement. In addition, Applicant notes that at least Figure 24 of the present application clearly illustrates a substantially planar guard. In view of this and in view of the decision of the court in In re Wolfensperger, 302 F.2d 950, 955-51; 133 USPQ 537, 541-43 (CCPA 1962), mentioned in

M.P.E.P. § 2181-IV, which explains that under 35 USC 112, first paragraph, the drawings must be considered. It is therefore submitted that the drawings provide antecedent basis and disclosure and can be relied upon by Applicant for purposes of 35 U.S.C. §112. In view of the foregoing, it is submitted that each of Claims 1-4, 32 and 33 fully comply with 35 U.S.C. §112.

Considering next then the rejection of Claims 212 and 223 under 35 U.S.C. §112, second paragraph, it is to be noted that appropriate amendments have now been made to such claims for compliance with 35 U.S.C. §112. However, should the Examiner have any remaining questions regarding these claims, the Examiner is invited to contact Applicant's attorney so that mutual agreement can be reached regarding the language of these claims.

Lastly considering then the rejection of Claims 1-4, 32, 33, 212-215 and 223 under 35 U.S.C. §103(a) as being unpatentable over Danks '773 in view of Danks '440, Applicant notes that each of independent Claims 1 and 212 claim a substantially planar guard having a distal end having a substantially uniform, continuous taper so as to form an edge angle smaller than a blade edge angle of the blade when viewed in plan view. In this regard, the substantial uniform, continuous taper is clearly illustrated, for example, in Figure 24 of the present application. Such also appears in Figures 26-33. To the contrary, it is noted that Danks '440 specifically requires the distal end of the shield 15 to be "bottle shaped" or "dolphin-nose shaped," the importance of which is described at column 6, line 59 through column 7, line 9 wherein it is emphasized that the blunt end 92 of the shield can move forward and be partially locked while still allowing sharpened edges 91 of the pointed blade 81 to expand the incision of the body cavity wall so that the obdurator and cannula may be introduced to into the body cavity. As can thus be appreciated, there is no teaching or disclosure in Danks '440 or Danks '773 of having the apex angle presently claimed. Moreover, any attempt to modify Danks '440 to meet Applicant's claim limitation would

clearly destroy Danks '440 for its intended purpose and function, which clearly is not obvious to one of ordinary skill in the art.

Applicants note that Claim 223 has been amended to claim that the insufflation passageway formed in the penetrator is substantially aligned with the main axis and is communicated to the cutting tip and to a distal portion of the hollow cannula of the substantially planar guard. This provides the advantage of airflow directly to the cutting tip so as to assist in movement away from the tip of the penetrator of internal organs beneath of the peritoneum as illustrated for example in Figures 6-8 and 28-33. This clearly differs from the teachings and disclosures of either Danks '773 or Danks '440 insofar as there is no teaching in either reference of communicating the insufflation passageway all the way to the cutting tip and to the distal portion of the substantially planar guard which are each at the point of entry into a patient at the time of use of the penetrator in accordance with the present invention. More particularly, as can be appreciated from a review of Danks '773 and Danks '440, any insufflation fluid communicated down the axis of the trocar would exit an end portion of the canular 13 and thus, for example, as shown in Figures 10A and 10B of Danks '440, the fluid provided by the insufflation passageway exits at a point which is spaced from the cutting tip and from the end portion of the shield 51 since the shield 51 is a solid member. Accordingly, the advantages as described in connection with the above-noted figures as mentioned in the specification is clearly not taught or disclosed and thus the structural limitations mentioned above in Claim 223 also have no corresponding teaching or disclosure in the above-noted references or any of the remaining references of record.

In view of the foregoing and in view of the additional arguments in support of the patentability of the claims, it is submitted that each of independent Claims 1 and 212 now merit indication of allowability. It is further submitted that each of dependent Claims 2-4, 32, 33, 213-215 and 223 merits patentability based upon their dependence upon Claims 1 or 212.

In view of the foregoing, an early and favorable Office Action is believed to be in order and the same is hereby respectfully requested.

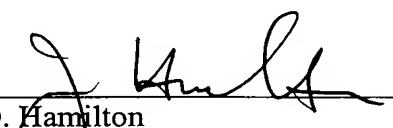
Respectfully submitted,

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